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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,697	03/09/2004	Benoit Abribat	U 0164-F04A	2889

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COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER
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CLARDY, S

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,697	<b>Applicant(s)</b> ABRIBAT ET AL.	
	<b>Examiner</b> S. Mark Clardy	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-17,19-30 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-17,19-30 and 32-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Claims 1-4, 6-17, 19-30, and 32-38 are pending in this application which claims benefit of US Provisional Application 60/453,768, filed March 11, 2003.

Applicants' claims are drawn to a microemulsion composition consisting essentially of the components listed below (claims 1-4, 6-12, 14-17, 19-25), methods of using the microemulsions (claims 13, 26), and methods of mixing them with agrochemicals (claims 27-30, 32-38). The microemulsion components are:

Oil<sup>1</sup>

Hydrophilic emulsifier<sup>2</sup>

Lipophilic co-emulsifier<sup>3</sup>

Optional customary additives<sup>4</sup>

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4, 6-8, 10, 11, 15-17, 19-21, 23, 24, 28-30, 32-34 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Again, using open claim language ("comprising") in the body of the dependent claims renders the normally limited scope of the phrase "consisting essentially of" in claims 1 and 28 void. While it is acceptable to have a claim read as "a composition comprising A, B, and C, wherein A consists essentially of D or E," it is inconsistent to do the reverse, i.e., "a composition consisting essentially of A, B, and C, wherein A comprises D or E". The former specifically limits a single component within the

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<sup>1</sup> Claims 2-4: comprising fatty acid ester (methyl oleate or laurate; mineral, vegetable, paraffinic, or silicone oils)

<sup>2</sup> Claim 6: comprising alkyl polyglycosides

<sup>3</sup> Claims 7-8: selected from glycerol or sorbitan esters such as glycerol monooleate or sorbitan monolaurate

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otherwise open language of the claim, while the latter pries opens the scope of the entire claim by opening the definition of a single component within the initially closed language of the claim. Either the independent claims should be amended to read “comprising”, or the dependent claims should be amended to match the closed language of the independent claims. Instead of “comprises” it would appear that the preferred term in the dependent claims is “is”.

Claims 10, 11, 23, and 24 have been corrected with respect to being duplicates of claim 1. However, composition claim 24 now incorrectly depends from method claim 13 (instead of composition claim 14). Correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 14 are now rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification or claims as originally filed of “non-alkoxylated nonionic surfactants”, nor is there any implicit reference requiring the subject nonionic surfactants to be nonalkoxylated. The phrase “non-alkoxylated” should be deleted.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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<sup>4</sup> Claim 12: antifreeze agents, dyes, thickening agents, antifoam agents, inorganic salts

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6-10, 12, 15-17, and 19-25 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (US 6,586,479).

Miller et al teach microemulsion ("fine emulsion", col 1, lines 12-16) adjuvant compositions comprising emulsifiers such as sorbitan esters (col 2, lines 42-46), nonionic surfactants such as alkylpolyglycosides (col 4, lines 39-48), oils such as fatty acid esters (col 5, lines 30-38), dyes and thickeners, (col 6, lines 35-52), and carriers such as vegetable oils, natural and hydrogenated oils, and liquid paraffins (col 6-7). The adjuvants are useful in combination with fungicidal active agents (col 7, lines 4-9), as claimed in claim 10. No other agrochemically active agents are disclosed. Thus applicants' components were known to have utility in making microemulsion compositions.

Claims 2-4, 6-10, 12, 15-17, and 19-25 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Klier et al (US 5,538,662).

Klier et al teach microemulsion compositions comprising gelling agent, organic solvent(s), and surfactant(s) (col 3, lines 12-14), wherein the solvents may be esters such as methyl laurate or methyl oleate (col 4, lines 18-47), or aliphatic hydrocarbons such as mineral oils or paraffin oils (lines 49-55). Before gelling, the microemulsions may be oil continuous, water continuous, or bicontinuous (abstract). Nonionic surfactants include glycerol and alkyl polyglycosides (col 6, lines 23-43). Optional components include dyes, disinfectants, and fungicides, among others (lines 57-67). Other than fungicides, no other agrochemically active agents are disclosed. Thus applicants' components were known to have utility in making microemulsion compositions.

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As noted above, the open language of the above rejected dependent claims allows for the additional agents disclosed in Miller et al and Klier et al.

Claims 1-4, 6-17, 19-30, and 32-38 are again rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Capuzzi et al (US 5,905,072) and Auda et al (US 6,586,366).

Capuzzi et al teach adjuvants for microemulsion fungicidal compositions (abstract) comprising methyl esters of fatty acids, anionic surface active agents such as sulfosuccinates, at least one nonionic surface active agent such as alkyl polyglucosides, and at least one additional nonionic surfactant such as sorbitan esters of fatty acids (col 1, lines 38-67; col 2, lines 44-62). The adjuvant microemulsions may also contain additives such as antifreeze and antifoam agents (col 3, lines 18-23), and active agents such as phytodrugs, phytochemicals, weed killers, insecticides, and fertilizers (col 4, lines 35-38).

Auda et al teach oil based emulsifiable concentrates and agrochemical formulations comprising at least one oil component, at least one saccharide surfactant, and at least one other nonionic surfactant (col 1, lines 9-15). When the composition contains water, it will form a microemulsion (lines 43-49). The oil component may be a mineral or vegetable oil, or a fatty acid ester such as methyl or ethyl laurate (lines 50-65). The saccharide surfactant may be an alkyl polyglucoside (col 2, lines 52-53). Other components may include antifoaming agents (col 3, line 35) and agrochemical agents such as herbicides, pesticides, insecticides, fungicides, or acaricides (lines 60-63), such as the herbicide glyphosate (columns 5-6).

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One of ordinary skill in the art would be motivated to combine these references because they disclose the same adjuvant materials as having utility in making microemulsion agrochemical compositions.

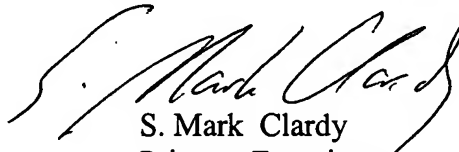
Thus it would have been *prima facie* obvious to the ordinary artisan at the time the invention was made to have combined applicants' oil, hydrophilic emulsifier, lipophilic co-emulsifier and customary additives into a single microemulsion composition because the prior art teaches that these components, and specific examples thereof as claimed herein, were known to be combinable in a single composition in order to produce a microemulsion composition which was useful for combining with agrochemicals.

No unobvious or unexpected results are noted; no claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is 571-272-0611. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



S. Mark Clardy  
Primary Examiner  
Art Unit 1617

August 2, 2006